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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/028,132	12/20/2001	Stuart T. Gordon	82142SMR	2406

7590 08/29/2003  
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12  
EXAMINER

LE, HOA VAN

ART UNIT	PAPER NUMBER
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1752

DATE MAILED: 08/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-12

<b>Advisory Action</b>	Application No. 10/028,132	Applicant(s) GORDON ET AL.	
	Examiner Hoa V. Le	Art Unit 1752	

--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 21 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 03 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.  
2. ☐ The proposed amendment(s) will not be entered because:  
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ they raise the issue of new matter (see Note below);  
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
5. ☒ The a) ☒ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.  
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.  
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1-6, 8-10 and 12-23

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.  
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.  
10. ☐ Other: \_\_\_\_\_

HOA VAN LE  
PRIMARY EXAMINER

Hoa V. Le  
Primary Examiner  
Art Unit: 1752

Continuation of 5. does NOT place the application in condition for allowance because: (1) the showings under Rule 132 have and given no value since the Nakai et al compared compound 2 is not relied on in the rejection on the record. Compound 57 as shown in Nakai et al Example 1, TABLE 2, Sample No. 107 is considered to be close and should have been tested instead of the non-relied up on and applied compound 2 and (2) Applicants urge that the general formula as broadly claimed is not now intend to include a Zn compound since the Office have discovered and applied by the Office on the record. There is no such exclusion embodiment in the claims as intended. Accordingly, the arguments alone are given no value as clearly pointed out and set forth on the record. Applicants should have provide an evidence that each of the applied Nakai et al compounds 29-30,34-35, 38,42, 45-48, 53-54, 57 and 86-94 does not have a property of the functional language in the claims as clearly pointed out and set forth on the record and allowed to be required by law. The claims have and are given no patentable value until applicants convincingly show such evidence as allowed and required by law. Please also see In re Schreiber, 44 USPQ2d 1429 state that "A patent applicant is free to recite features of an apparatus either structurally or functionally. See In re Swinehart... 169 USPQ 226, 228... Yet, choosing to define an element functionally, i.e., by what it does, carries with a risk. As our predecessor court state in Swinehart... where the Patent Office has reasons that the functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on." There is no suggestion of an additional amendment or showing because it may not be considered.

HOA VAN LE  
PRIMARY EXAMINER

*Hoa Van Le*

*27 August 2003*